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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,455	03/25/2004	Darko Pervan	1033462-000045	4858
21839	7590	11/27/2009	EXAMINER	
BUCHANAN, INGERSOLL & ROONEY PC POST OFFICE BOX 1404 ALEXANDRIA, VA 22313-1404				GILBERT, WILLIAM V
ART UNIT		PAPER NUMBER		
3635				
			NOTIFICATION DATE	DELIVERY MODE
			11/27/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/808,455	PERVAN, DARKO	
	<b>Examiner</b>	<b>Art Unit</b>	
	William V. Gilbert	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 September 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1 and 3-19 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1, 3-19 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>3/6/09; 10/8/09</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

This is a first action following a Request for Continued Examination. Claim 2 has been cancelled. Claims 1 and 3-19 are pending and examined.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 17 September 2009 has been entered.

***Double Patenting***

2. **Claims 1 and 3-19** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6, 7, 9-13 and 16-20 of copending Application No. 10/975923. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are substantially similar as noted below.

**10/808455**

**10/975923**

1	6
3, 4, 5	7
6	9
7	10
8, 11	12
9, 12	13
10	11
13, 19	16
14, 16	18
15	17
17	19
18	20

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1, 3-5 and 13-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Evjen (U.S. Publication 2004/035079) in view of Theirs (U.S. Publication 2006/0032168).

Claim 1: Evjen discloses a floor panel system comprising rectangular floorboards (paragraph 0044) which are mechanically lockable, the system having pairs of opposing connectors for locking similar floorboards both vertically and horizontally (Figs. 1B-1E also 18 and 26) and the other sides have connectors that lock only horizontally (Fig. 5A), the connector of the floorboards are designed to allow locking together of one of the

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sides (the one locked both vertically and horizontally) by angling along an upper joint edge (see Figs. 1B-1E generally; see paragraph 0033). While Evjen discloses that the panels can be rectangular, it does not disclose which connection is used on the long side and which connection is used on the short side. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the vertical and horizontal connection on the long sided and the "horizontal connection only" on the short side because the connection can function properly with either connection on the long or short side. In addition, Evjen does not disclose the panels are in a mirror-inverted fashion. Thiers discloses panels (Fig. 1: 2, 3) that appear to be mirror images (as shown in the drawings.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have two panels that are mirror images in order to provide the options for additional pattern forming with the panels. Applicant should respectfully note that the particular connection in Thiers is not the focus of the rejection, but rather that panels can be made in a mirror-image fashion for connection. Further, applicant has not respectfully positively recited that the mirror-inverted panels are connected to each other.

Claim 3: the horizontal locking is by an essentially vertical motion (Evjen: Fig. 5A).

Claims 4 and 5: the floorboards are disconnectable by an angular motion away from the subfloor (portion shown in Fig. 5A would be disconnected by a vertical angle.)

Claim 13: Evjen discloses rectangular floor panels having two sides that lock both vertically and horizontally (Figs. 1B-1E, 18 and 26) that allow locking together by an angular motion along an upper joint edge (See Figs 1B-1E generally) and two sides allow locking together by an essentially vertical motion (Fig. 5A), and a first row is joined to a second row (see explanation above of "mirror-inverted". While Evjen discloses that the panels can be rectangular, it does not disclose which connection is used on the long side and which connection is used on the short side. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the vertical and horizontal connection on the long sided and the "horizontal connection only" on the short side because the connection can function properly with either connection on the long or short side. In addition, Evjen does not disclose the panels are in a mirror-inverted fashion. Thiers discloses panels (Fig. 1: 2, 3) that appear to be mirror-inverted (as shown in the drawings.) It would have been obvious at the time

the invention was made to a person having ordinary skill in the art to have two panels that are mirror-inverted in order to provide the options for additional pattern forming with the panels. Applicant should respectfully note that the particular connection in Thiers is not the focus of the rejection, but rather that panels can be made in a mirror-image fashion for connection.

Claims 14 and 16: the floorboards are in parallel rows (see Thiers: e.g. Fig. 1 where panels, 3, are in parallel rows.)

Claim 15: the short sides have cooperating locking surfaces, which are different from the cooperating locking surfaces on the long sides (as shown in the drawings in Evjen.)

Claim 17: Evjen discloses a method for making a flooring of rectangular floorboards where two opposing sides can lock both vertically and horizontally (e.g. Fig. 1B, 18 and 26) and two sides lock only in the horizontal direction (Fig. 5A), the first connection allows locking by an angular motion (see Fig. 1B, generally) at an upper joint edge. While Evjen discloses that the panels can be rectangular, it does not disclose which connection is used on the long side and which connection is used on the short side. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have the vertical and horizontal connection on the long side

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and the "horizontal connection only" on the short side because the connection can function properly with either connection on the long or short side. In addition, Evjen does not disclose the panels are in a mirror image fashion. Thiers discloses panels (Fig. 1: 2, 3) that appear to be mirror inverted (as shown in the drawings.) It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have two panels that are mirror-inverted in order to provide the options for additional pattern forming with the panels. Applicant should respectfully note that the particular connection in Thiers is not the focus of the rejection, but rather that panels can be made in a mirror-inverted fashion for connection. The result of this combination of the prior art of record would result in the panels being connected as claimed.

Claim 18: Evjen discloses a flooring system with a first pair of connection that locks in the vertical and horizontal direction (Fig. 1B) and a second pair of connections that lock the panel only horizontally (Fig. 5A), the floorboards are laminate (paragraph 0016) and the joining and disconnecting is angular. While Evjen discloses that the panels can be rectangular, it does not disclose which connection is used on the long side and which connection is used on the short side. It would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to have the vertical and horizontal connection on the long sided and the "horizontal connection only" on the short side because the connection can function properly with either connection on the long or short side. In addition, Evjen does not disclose the panels are connected in a herringbone fashion. Thiers discloses panels (Fig. 1: 2, 3) that appear to be mirror images (as shown in the drawings,) and connected in a herringbone pattern (e.g. Fig. 1). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have two panels that are mirror images in order to provide the options for additional pattern forming with the panels. Please note, however, that the mirror inversion is not necessary to achieve a herringbone pattern. The panels can be made in numerous configurations (Evjan paragraph 0044), so it would be within the level of skill in the art to make the panels such that a herringbone pattern could be formed without mirror inversion. In other words, the Thiers reference is used primarily to denote a herringbone pattern.

Claim 19: Evjen discloses the short sides are adapted for locking the floorboards only horizontally (5A).

***Allowable Subject Matter***

4. **Claims 6-12** are allowed.

***Response to Arguments***

5. Applicant's arguments filed 17 September 2009 have been fully considered but they are not persuasive.

Regarding independent claim 1, applicant claims a system, and limitations drawn to the system including the connection and "mirror-inversion". Applicant, however, has not provided the relationship between the two types of panels, only that one is inverted and one is not. The examiner respectfully disagrees with applicant's position with regards to the Thiers case (arguments page 9). Theirs was presented to show that it is known in the art to make panels in a "mirror-inverted" manner, such as presented in the claimed invention. Theirs teaches different connections than that presented in the Evjen patent (cited above). The examiner noted that the particular connection in Theirs was not the focus of the rejection, but rather to show that it is within the level of skill in the art to make panels in a mirror-inverted manner. The examiner maintains the rejection as proper.

Regarding independent claim 13, while applicant claims a connection between two rows of floorboards, the boards being of a mirror-inverted type, the examiner maintains that this can be achieved. See for example Evjen Fig. 4B, where four panels are connected. One of ordinary skill in the art could take a mirror-inverted panel and place the tongue (18) of the inverted panel into the groove (20) of another row. This would meet the limitation of placing a "a floorboard of the second type [the inverted one] in a new row to a last laid floorboard of the first type [as shown in the drawing] in a preceding row." The same argument applies to independent claims 17.

Regarding claim 18, applicant does not require that the panels be mirror inverted, but only in a herringbone pattern. Theirs was cited to show a panel with a herringbone pattern, but it would not be necessary to mirror invert the panels in Evjen to achieve this pattern. The panels can be shaped without mirror inversion to achieve a herringbone pattern, and Evjen notes that numerous embodiments are within the level of skill in the art (paragraph 0044).

### ***Conclusion***

6. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635